

REMARKS

This paper is responsive to an Office Action mailed December 10, 2007. Prior to this response, claims 1-40 were pending. After amending claims 1, 3-4, 6, 9-11, 13-14, 16, 20, 22-23, 26-28, and 30-37, canceling claims 2, 8, 12, 18-19, 21, 29, and 39-40, and adding claims 41 and 42, claims 1, 3-7, 9-11, 13-17, 20, 22-28, 30-38, and 41-42 remain pending.

In Sections 1 and 2 of the Office Action, objections have been made to the drawings. In response, Replacement Sheets were filed on February 5, 2008. Fig. 9 (Sheet 8) was modified to include reference designator “910”, and Fig. 14 (Sheet 13) was modified to include reference designators “1410a” and “1410b”.

In Section 4 of the Office Action, claims 1-5, 7, 15-17, 20-26 and 28 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Carney et al. (“Carney”; US 2002/0080389) in view of Richter et al. (“Richter”; US 6,678,068). On page 16 of the Office Action it is acknowledged that the combination of Carney and Richter fail to disclose the limitation of sending jobs to a device along with a client network address, which is the subject matter of claims 8 and 29. Claims 1 and 20 have been amended to include the subject matter of claims 8 and 29 (now canceled). Since claims 1 and 20 include subject matter not found in the prior art references, the Applicant respectfully requests that the rejection of claims 1 and 20 be removed. Claims 3-5, 7, and 15-17, dependent from

claim 1, and claims 22-26 and 28, dependent from claim 20, enjoy the same advantages over the cited prior art.

In Section 5 of the Office Action claims 6, 18-19, 27, and 40 have been rejected over Carney and Richter, in view of Kullick et al. (“Kullick”; US 5,898,823). Claims 1 and 20 have been amended to include the subject matter of claims 8 and 29, respectively. On page 16 of the Office Action it is acknowledged that the combination of Carney and Richter fail to disclose the limitation of sending jobs to a device along with a client network address, which is the subject matter of claims 8 and 29. Kullick does not disclose this limitation either. Dependent claims 6 and 27 include the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

In Section 6 of the Office Action claims 8-9, 11, 29-30, 32, and 36-38 have been rejected over Carney and Richter, in view of Sorkin et al. (“Sorkin”; US 5,898,823). With respect to claims 8 and 29, now included in the subject matter of claims 1 and 20, respectively, the Office Action acknowledges that Carney fails to disclose a process that filters the job record by matching client and job network addresses. The Office Action states that Richter discloses this feature, and that it would have been obvious to combine the references because it would have been advantageous to view information regarding printing devices, receive information regarding print jobs, and to have an administrative user view and control the status of the print system. The Office Action acknowledges that neither Carney nor Richter disclose the client sending jobs to a device along with the client network address, but states that

Sorkin discloses this feature. The Office Action states that it would have been obvious to combine Sorkin with Carney and Richter to create a system that did not rely on human interaction to determine the printer address. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

- A) Combining prior art elements according to known methods to yield predictable results;
- B) Simple substitution of one known element for another to obtain predictable results;
- C) Use of known technique to improve similar devices (methods, or products) in the same way;
- D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Carney would have been obvious to one of ordinary skill in the art in light of Richter and Sorkin. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

- (1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;
- (2) a finding that there was a reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Carney discloses a process that monitors print jobs. However, Carney does not disclose any means of filtering or cross-referencing print jobs to the clients sending the jobs

At col. 2, ln. 7-15, Richter discloses a prior art process of a print driver user interface that permits a user to select print options and a destination printer. Generally, Richter discloses a system that established a 2-way link between a client computer and a printing system, where the printing system includes a print server interposed between the

client computer and the printers (col. 3, ln. 22-39). The print server is able to provide information to the client such as job status, and when a "jam" occurs (col. 5, ln. 18-30). However, the Applicant can find no evidence that Richter creates a filtered history of jobs associated with a client, as suggested in the Office Action.

Sorkin discloses a process where a client device sends a "non-print job" having a header that includes the network address of the sending computer (col. 2, ln. 20-26). An acknowledgement is sent from the printer to the sending computer. The acknowledgement includes the network address of the printer. Through this means computer learns the network address of the printer, and is able to send a certain class of communications to the printer, bypassing the spooler (col. 2, ln. 26-41). From this analysis it can be seen that Sorkin does not send a client address with a print job. Rather, Sorkin sends the client address in a separate "non-print job" type of message. While Sorkin may disclose a method of determining a *printer* address, he does not disclose a process of filtering job history by client address. Neither does Sorkin disclose a process of determining the address of the sending client, as the printer has no use for the client address that is sent to the printer in the "non-print job".

With respect to the above-referenced first factual analysis criteria, the Richter and Sorkin references has been combined with Carney based upon the assumption that the combination of references discloses all the limitations recited in Applicant's amended claims 1 and 20. While the combination of Carney and Richter may potentially be cited as suggesting a means for a client to access print-job related information,

the combination does not disclose creating a history of jobs filtered by the address of the sending client. Carney and Richter do not suggest a means of filtering, as they do not send a client network address with the print job. As noted above, Sorkin does not disclose this feature either, as Sorkin does not keep a history of jobs or filter jobs. Sorkin discloses no means of filtering, as his printer does not store the network address of the sending client computer in memory. Therefore, even if Carney, Richter, and Sorkin are combined together, that combination does not explicitly disclose every limitation of amended claims 1 and 20. Claims 9 and 11, dependent from claim 1, and claims 30, 32, and 36-38, dependent from claim 20, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Sorkin together with Carney and Richter to provide a system that does not rely on human interaction to determine printer address. However, the motivation to monitor a printer address does not suggest a process of filtering a job history record, or the sending of a client address along with the print job to enable the filtering. A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Carney reference. However, there is nothing in the Richter and Sorkin references that suggests such a modification.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)analysis

[of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to filter a job history record, or to send a client address along with the job to enable the filtering.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Carney, Richter, and Sorkin references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Carney, Richter, and Sorkin does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be

modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 9, 11, 30, 32, and 36-38 be removed.

In Section 7 of the Office Action claims 10 and 31 have been rejected over Carney, Richter, and Sorkin, in view of Saruwatari (US 2002/0059361). The Office Action acknowledges that Carney/Richter/Sorkin fail to disclose a client sending an IP address, but that Saruwatari discloses this feature, and that it would have been obvious to combine the references because it would have been easier to locate a client in a printing network. This rejection is traversed as follows.

Even if Saruwatari's IP address is combined with Carney/Richter/Sorkin, the combination does not disclose the limitations of filtering a job history record, or sending a client address along with the job to enable the filtering. These missing limitations are not suggested by the assertion that Saruwatari's IP address would make a client easier to find. Further, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

A *prima facie* case of obvious has not been supported since the combination of Carney, Richter, Sorkin, and Saruwatari does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 10 and 31 be removed.

In Section 8 of the Office Action claims 12-14 have been rejected over Carney, Richter, and Kullick, in view of Sorkin. The Office Action acknowledges that Carney/Richter/Kullick fails to disclose a client sending jobs to a device along with the client network address, but that Sorkin discloses this limitation. As noted in response to the rejections made in Section 5 of the Office Action, Sorkin does not disclose the above-mentioned limitation. That is, the combination of references does not disclose the limitations of filtering a job history record, or sending a client address along with the job to enable the filtering. Further, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

A *prima facie* case of obvious has not been supported since the combination of Carney, Richter, Kullick, and Sorkin does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 13-14 be removed.

In Section 9 of the Office Action claims 33-35 and 39 have been rejected over Carney, Richter, and Sorkin, in view of Kullick. The Office Action acknowledges that Carney/Richter/Sorkin fail to disclose a client local memory, but that Kullick discloses this feature, and that it would have been obvious to combine the references. This rejection is traversed as follows.

Even if Kullick's local memory is combined with Carney/Richter/Sorkin, the combination does not disclose the limitations

of filtering a job history record, or sending a client address along with the job to enable the filtering. These missing limitations are not suggested by the assertion that Kullick's local memory would make it easier for a user to check the repository. Further, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

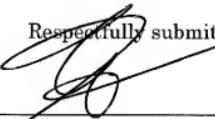
A prima facie case of obvious has not been supported since the combination of Carney, Richter, Sorkin, and Kullick does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Carney can be modified to supply the missing limitations in view of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 33-35 removed.

Claims 41 and 42 have been added. Support for this subject matter can be found in the specification on page 14, lines 9-18. None of the references cited in the Office Action disclose a process of maintaining a history of job records at the device, which is sent to the client for filtering.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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